

Serial No.: 10/810,347
Docket No.: PULT 9283



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/810,347
Applicant	:	Terry Pullaro
Filed	:	March 26, 2004
Title	:	SPORTS TRAINING AND CONDITIONING DEVICE
TC/A.U.	:	3711
Examiner	:	Alvin A. Hunter
Conf. No.	:	8229
Docket No.	:	PULT 9283US

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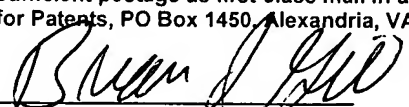
APPELLANT'S REPLY BRIEF TO EXAMINER'S ANSWER (37 CFR 41.41)

This brief contains these items under the following headings and in the order set forth below (37 CFR 41.37 and M.P.E.P 1208):

- I. IDENTIFICATION PAGE.
- II. STATUS OF CLAIMS.
- III. GROUNDS OF REJECTION TO BE REVIEWED.
- IV. ARGUMENT.
- V. CONCLUSION.

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Brian J. Gill, Reg. No. 46,727

Serial No.: 10/810,347
Docket No.: PULT 9283

I. IDENTIFICATION PAGE

- A. Appellant's Name: Terry Pullaro
- B. Serial Number: 10/810,347
- C. Filing Date: March 26, 2004
- D. Title of the Invention: SPORTS TRAINING AND CONDITIONING
DEVICE
- E. Examiner: Alvin A. Hunter
- F. Art Unit: 3711
- G. Title of the Paper: APPELLANT'S REPLY BRIEF TO EXAMINER'S
ANSWER

II. STATUS OF CLAIMS (37 CFR 41.37(c) (1) (iii))

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Pending claims in the application are Claims 1 and 4-14

B. STATUS OF ALL THE CLAIMS

Under 37 C.F.R. 41.37(c) (1) (iii), claims 1 and 4-14 are rejected and claims 2, 3 and 15-17 are cancelled.

C. CLAIMS ON APPEAL

Claims 1 and 4-14 are the claims appealed.

**III. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
(37 CFR 41.37(c) (1) (vi))**

The following grounds of rejection are requested to be reviewed on appeal:

Claims 1 and 6-14 have been rejected by the Examiner under 35 U.S.C. §103(a) as being allegedly unpatentable over the "Smith reference" (U.S. Patent No. D241,958) in view of the "Huffman reference" (U.S. Patent No. 5,215,307) and the "Piccini reference" (U.S. Patent No. 4,378,113) further in view of the "Spivey reference" (U.S. Patent No. 4,272,077). Claims 4 and 5 have been rejected by the Examiner under 35 U.S.C. §103(a) as being allegedly unpatentable over the prior art applied in claim 1 in view of the "Hart reference" (U.S. Patent No. 6,379,261).

IV. ARGUMENT (37 CFR 41.37(c) (1) (vii))

Appellant reaffirms the arguments made in Appellant's Brief, filed December 28, 2007. The Appellant submits his appreciation for the correction of the "Status of Amendments After Final" provided by the Examiner in the Examiner's Answer

A. Claim Rejection Under 35 U.S.C. §103(a)

The Examiner's Answer reiterates the rejection of Claims 1 and 6 as being allegedly unpatentable over the "Smith reference" in view of the "Huffman reference") and the "Piccini reference" further in view of the "Spivey reference".

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure." M.P.E.P. § 2143. The recent *KSR* decision has not altered these requirements.¹

Because the references relied upon by the Examiner to establish obviousness do not disclose or suggest a single weight at the end of the shaft to

¹ *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007)

provide an unbalanced force, these prior art references fail to disclose all of the elements of Claim 1.

I. The *KSR* Decision and the Law of Obviousness

The Supreme Court in the *KSR* decision reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co.*², but stated that the Federal Circuit had erred by applying the teaching-suggestion motivation test in an overly rigid and formalistic way.³ In *KSR*, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed factors in which a patent might be determined to be obvious.⁴ When considering obviousness of a combination of known elements, the operative question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.”⁵

II. The Basic Factual Inquiries of *Graham v. John Deere Co.*

As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in the *Graham* decision.⁶ Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows: (A) determining the scope and content of the prior art; (B) ascertaining the

² 383 U.S. 1 (1966)

³ *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391

⁴ *Id.* at ___, 82 USPQ2d at 1395

⁵ *Id.*

⁶ 383 U. 1 (1966)

differences between the claimed invention and the prior art; and (C) resolving the level of ordinary skill in the pertinent art.⁷

The Court in *Graham* “recognized the importance of guarding against hindsight, as is evident in its discussion of the role of secondary considerations as ‘ser[ving] to guard against slipping into use of hindsight and to resist the temptation to reading into the prior art the teachings of the invention at issue’”.⁸

The question of obviousness must be resolved on the basis of these factual determinations. While each case is different and must be decided on its own facts, the *Graham* factors are the controlling inquiries in any obviousness analysis.⁹

III. The Examiner Has Failed To Explain Any Rationale To Support Rejections Under 35 U.S.C. 103

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The Examiner must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The “mere existence of differences between the prior art and an invention does not establish the invention’s non-obviousness.”¹⁰ The difference between the prior art and the claimed invention may not be “so great as to render the [claim] nonobvious to one reasonably skilled in the art.”¹¹

⁷ *Id.*

⁸ *Alza Corp. v. Mylan Laboratories, Inc.*, 464 F.3d 1286 (Fed. Cir. 2006))(quoting *Graham*, at 36).

⁹ *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391.

¹⁰ *Dann v. Johnston*, 425 U.S. 219 (1976)

¹¹ *Id.*

The key to supporting any rejection under 35 U.S.C. 103 is the clear explanation of the reason(s) why the claimed invention would have been obvious.¹² The Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn* stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”¹³

These rationales include:

“Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.”¹⁴

If the search of the prior art and the resolution of the *Graham* factual inquiries reveal that an obviousness rejection may be made using the familiar teaching-suggestion-motivation (TSM) rationale, then such a rejection using the TSM rationale can still be made.¹⁵ Although the Supreme Court in *KSR* cautioned against an overly rigid application of TSM, it also recognized that TSM was one of a number of valid rationales that could be used to determine obviousness.¹⁶ As the Federal Circuit has found, “a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis.” *Ortho-McNeil*

¹² Federal Register, Vol. 72, No. 195, p. 57528 (October 10, 2007)

¹³ *KSR*, at ___ (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))

¹⁴ *Id.*

¹⁵ Federal Register, Vol. 72, No. 195, p. 57528 (October 10, 2007)

¹⁶ According to the Supreme Court, establishment of the TSM approach to the question of obviousness “captured a helpful insight.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

Pharmaceutical, Inc. v. Mylan Laboratories, Inc., ___ F.3d ___, (Docket No. 2007-1223, Fed. Cir. Decided March 31, 2008 at page 11) (citing *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of the invention.”)). The *Ortho* court states that the “TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence – teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) that arise before the time of the invention as the statute requires.” *Id.*

To reject a claim based on the TSM rationale, the Examiner must resolve the *Graham* factual inquiries. The Examiner must then articulate the following:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and

(2) a finding that there was reasonable expectation of success.¹⁷

The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.¹⁸

¹⁷ Federal Register, Vol. 72, No. 195, p. 57534 (October 10, 2007)

¹⁸ *Dystar Textilfarben GmbH & Co. Deutschland Kg v. C.H. Patrick Co.*, 464 F.3d 1366, 80 USPQ2d 1641 at 1649 (Fed. Cir. 2006)

IV. Analysis Of The Cited References Viewed in this light, the Examiner's rejection is clearly erroneous.

The Smith reference is particularly deficient. As a design patent, nothing is known about the device except for the way the device looks. Even then, the design element appears to be a V shaped structure shown in Figure 1.

The Huffman reference cannot properly be combined with the Smith reference, if the Smith reference, for the purposes of argument, has some meaning not evident on the face of the design as applied by the Examiner, because the Huffman reference specifically teaches away from the Smith reference. The Smith reference shows a structure at one end (and because the Smith reference is a design patent, it is not clear what that structure is). Assuming for the sake of argument that the structure is some form of weight, the combination being made by the Examiner is improper. The problem that the Huffman reference allegedly solves is, as stated at Column 1, lines 19-22: "What is needed is a weighted exercise device that will allow the user to practice the specific swing of a given sport such as golf, tennis or baseball but not affect the balance of the user while performing the exercise." The two concepts are mutually exclusive, and the combination made by the Examiner is respectfully suggested to be erroneous.

The Huffman reference teaches a training exercise method. The method provides a normal balance to the user while the user swings a counter weighted device. (See: Abstract)(Emphasis added). The device includes a shaft with weights at opposing ends that counter balance each other. In the Background

Section, the Huffman reference discloses that a training device having a weight at only one end of a training device results in the disadvantage of pulling the user toward the weight. (See: Col. 1, lines 10-11).

Furthermore, the Huffman reference discloses that a need exists for an exercise method that does not affect the balance of the user while performing the exercise. (See: Col., lines 20-21). In fact, the Huffman reference states that the “key is the counter balanced weights at opposite ends of the shaft with one of the weights being between the hands on the grip and the user’s body.” (See: Col. 2, lines 54-57)(Emphasis added). In contrast, the Smith reference teaches a single structure at one end.

Applicant’s claim 1 recites that the positioning of the non-rotatable weight, the positioning of its center of mass and the sizing of the handle circumference are configured to direct the effect of the weight in a concentrated manner to the forearms of the user. In other words, the single weight of the present application results in an unbalanced force in order to direct the concentration of the effect of the weight to the user’s forearm. Furthermore, in order to concentrate the effect of the weight to the user’s forearm, the weight must be at the end of the shaft. As such, the weight of the present application is not positioned between the user’s hand and the user’s body as taught and emphasized by the Huffman reference.

Since the present application uses a single weight at the end of the shaft to provide an unbalanced weight, one skilled in the art would not be motivated to seek out the Smith reference and combine it with the Huffman reference due to

the required balanced weights and the stated objectives of the Huffman reference.

The Piccini reference, alone or in combination with the Smith reference likewise is deficient. First, it also teaches away from the claimed invention in that it has variable weights. Second, it is exercise specific, stating at column 1, 9-11, that “[t]his invention relates to warm-up exercises for athletes and more particularly to wrist warm-up exercises for baseball players. “ Applicant’s claim 1 as presently presented also is exercise specific, but the exercise specific structure required by claim 1 (and not shown in the art) applies to the forearms, not the wrists. That is not a distinction without a difference, in that in many sports, it is the forearm that requires strengthening.

In particular, the Piccini reference teaches method of warming up wrists by manipulating a club-like implement having a truncated handle and a body. (See: Column 2, lines 4-6). The body includes a sloping hollow chamber that is partially filled with water. (See: Column 2, lines 6-8; Fig. 2). The implement has an abbreviated handle to prevent the athlete from grasping the implement in the same manner that he would grasp a baseball bat or golf club. (See: Column 2, lines 19-23)(Emphasis added). As taught by the Piccini reference, “[b]y providing the abbreviated handle portion, the inventor has provided a device which deliberately makes no effort to simulate the feel of an actual athletic implement.” (See: Column 3, lines 11-13)(Emphasis added).

In contrast, Applicant's claim 1 recites that the handle is shaped like the grip portion of the implement. As noted, the Piccini reference deliberately makes no effort to simulate the feel of an actual athletic implement. Furthermore, claim 1 recites that the weight's shape, the sizing of the circumference of the handle and the positioning of the center of mass are configured to direct the effect of the weight in a concentrated manner to the forearms of the user. (Emphasis added).

The Spivey reference is even more remote, and truly demonstrates that the Examiner has used Applicant's specification to combine unrelated pieces of prior art, having little or no relationship to Applicant's structural combination to fashion an improper rejection. The Spivey reference is a "Golf Club Putter Grip." The whole purpose of the Spivey reference is to improve the user's putting by "minimizing putter jerks or yips by preventing the non-dominant hand from overriding the dominant hand." (See: Abstract). This reference uses a formula determined by hand sizes that forces the grip of the non-dominant putting hand to be in a relaxed position so that it does not pull against the putting motion of the dominant hand. (See: Column 1, lines 31-34). As shown in Figs. 4 and 5, a measurement of the golfer's hand is taken to size the distance between the tip of the index finger and the metacarpo phalangeal joint. This measurement is used to determine the circumference of the golf putter grip. (See: Column 2, lines 55-68). By having the non-dominant hand around this sized grip, the non-dominant hand is in the as near as possible relaxed position. (See: Column 3, lines 25-

30)(Emphasis added). During use, the dominant hand of the golfer grips the putter tightly while muscles in the non-dominant hand remain relaxed.

The Spivey reference is not concerned with any of the problems overcome by Applicant's device or the structural combination as a whole of Applicant's claim 1. In contrast, Applicant's claim 1 recites that positioning of the normally non-rotatable weight and the handle circumference direct the effect of the weight in a concentrated manner to the forearms of the user. In other words, both forearms of the user are flexed (i.e., non-relaxed as stated in the Spivey reference).

One skilled in the art would not be motivated to seek out the counter weight of the Huffman reference, the truncated handle of the Piccini reference and the formula of the Spivey reference and to combine with the ornamental features of the Smith to arrive at the presently claimed invention.

The rejection of the claims has not provided a *prima facie* case of obviousness as the rejection has not determined the scope and contents of the references and has not ascertained the differences between these references and the present claim. The Examiner has not explained what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination of the references. Since the Examiner has not provided a suggestion to combine the references, then there is no finding of a reasonable expectation of success of the combination.

The Examiner's analysis is directed to ways that the references can be combined to be read on the claimed invention as opposed to pointing to specific information in the references that suggest the combination. The rationale to support a conclusion that the claim would have been obvious is that a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.

V. Conclusion

For at least the foregoing reasons, Claims 1 and 4-14 are believed to be in condition for allowance. The Commissioner is hereby authorized to charge any extension of time fee and additional fees or credit overpayment under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account 162201. The Commissioner is hereby authorized to charge any fees or credit overpayment under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account 162201.

Date: May 19, 2008

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Brian J. Gill", is written over a horizontal line.

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